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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
YOO, JASSON H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/655,488

Applicant(s)

ROTHSCHILD ET AL.

Examiner

JASSON H. YOO

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/08 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Furthermore, claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-28, 33-51 incorporate the limitation of a universal personal identifier object in a form of a tangible object whose primary purpose is not direct to identifying the patron at a particular game venue. If a "universal personal identifier object" as the term implies, is universally used to identify a patron, then the "universal personal identifier object" should be used to identify a patron regardless of where the person is located. Hence, the terms "universal personal identifier object" contradict with the limitation of whose primary purpose is not directed to identifying the patron at a particular game venue. Furthermore, Applicants fail to disclose what a "universal personal identifier object" could be in which it is universally used to identify a patron, but not primarily used at a particular game venue. It is not clear how an object can universally be used to identify a person, but not be primarily be used to identify the patron at a particular game venue. The specification does not state that the "universal personal identifier object" is not primarily used to identifying the patron at a particular game venue. The only possible examples of the "universal personal identifier object" are: biometric characteristics of a person (i.e. a finger used to take a fingerprint), a credit card, or a driver's license. These objects may be used to identify a person outside a game venue (perhaps considered as universally used) and may have other functions outside of a game venue. However, when using these items within a gaming environment, the objects' primary purpose is changed. In the claims, these objects have a patron identification associated with a patron. Thus, these objects have a primary purpose of being used to identify the patron at the gaming venue when they are used in a gaming environment to have patron identification associated with a patron.

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For example, a driver's license primary purpose is used to allow a person driver an automobile. However, when used in a casino to identify the person, the primary purpose for the driver's license within the casino is used to identify the person. Additionally, Applicants fail to disclose the different embodiments of the "universal personal identifier object" as claimed in the dependent claims. For example, the specification fails to disclose the "universal personal identifier objects" in the form of a memory stick, Bluetooth mobile phone, or Bluetooth mobile device. It is not clear how a memory stick, a smart card, a cell phone, a PDA, etc. is universally used to identify a person. Claims 29-32 are rejected for similar reasons as discussed above. Here, the limitation of a Bluetooth portable device having a primary purpose that is different than for identifying a patron at a particular game venue contradicts the terms a "unique gaming identification" associated with a player that is obtained from a Bluetooth portable device when used in a gaming environment. Furthermore, Applicants fail to teach this limitation as discussed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-23, 25-46, 48 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick et al (US 6,908,387) in view of Giobbi (US 2003/0045354)

1, 15, 38. Hedrick discloses a server based network (Fig. 5) and a method for associating a patron with wagering game play at a gaming machine in a server-based gaming network, the method comprising:

associating a unique patron gaming identification with the patron (associate a player with a player tracking account, col. 2:20-23);

establishing a patron account for the patron, the patron account being identified by the unique patron identification (establish a patron account with player tracking information, cols. 1-46-2:25, 3:5-33);

receiving, at a universal personal identifier device (UPI device) associated with the gaming machine (player tracking unit 107 in Fig. 1, 200 in Fig. 2a, 300 in Fig. 3), a universal personal identifier object (UPI object) in a form of a tangible object (Hedrick, discloses a plurality of player tracking objects such as cards, biometric inputs, and wireless devices, cols. 3:12, 10:24-56. The player tracing object is detected by any of the plurality of gaming machines 600-601 that contains the player tracking unit, 200. Thus Hedrick's player tracking units are interpreted as "universal personal identifier objects" because Hedrick's player tracking units are universally recognized by the gaming machines.), the UPI object having a patron identification (contains, player tracking account number, col. 3:13), the UPI device for detecting and transmitting the patron identification (the UPI device reads the tracking information from the player tracking devices, and relays it to the player tracking server, col. 3:5-33);

receiving at a location within the server-based gaming network that is remote from the gaming machine, the patron identification obtained from the UPI device associated with gaming machine (the tracking information is relayed to the player remote tracking server, col. 3:5-33, See Fig. 5);

comparing the patron identification to the unique patron identification (col. 3:23-33); and

collecting patron accounting data resulting from wagering game play if the patron identification matches the unique patron identification (col. 3:22-47).

Regarding claim 38, see above, Hedrick further disclose a server-based gaming network that allows a patron with a universal personal identifier to be associated with wagering game play at a gaming machine, the server-based gaming network comprising:

a plurality of gaming machines (Hedrick, 100, 101, 102, 103, in Fig. 1), at least one of the gaming machines comprising:

a value input device (Hedrick, 220 in Fig. 3 and 32 in Fig. 4);

a video display capable of displaying video images associated with the wagering game play (34 in Fig. 4);

a universal personal identifier device (player tracking unit 107 in Fig. 1, 200 in Fig. 2a, 300 in Fig. 3) configured to detect the patron identification from the UPI object (Hedrick, discloses a plurality of player tracking objects such as cards, biometric inputs, and wireless devices, cols. 3:12, 10:24-56);

a gaming machine controller (Hedrick, 104 in Fig. 1); and

a server (120 in Fig. 5).

Hedrick discloses the claimed invention as discussed above, but fails to specifically teach the universal personal identifier object is in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game venue. The 112 rejection above discusses how this negative limitation is not disclosed in Applicants' specification, and fails to meet the enablement requirement. Furthermore, the specific primary purpose in which an apparatus is used is intended use of the apparatus. Even so, the primary purpose of how the UPI object is used is not claimed. The claimed invention is based on the features that are claimed. Since the primary purpose in which the UPI object is used is intended use of the apparatus, and the primary purpose of how the UPI object is used is not claimed or related to the claimed invention, Hedrick discloses the claimed server based network comprising a UPI object (as claimed in claim 38). Claims 1 and 15 are directed to a method of associated a patron with a wagering game. The method comprises, receiving at a UPI device a UPI object. The limitation of what the UPI primary purpose is does not further limit the claimed method in which the UPI device receives a UPI object. The claims also fail to disclose what the primary purpose is. Since the claimed invention is examined on what the method or apparatus is, rather than what it is not, it can be interpreted that Hedrick discloses the claimed invention.

Furthermore, in an analogous art to player tracking devices for game machines, Giobbi discloses a universal personal identifier in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular game venue, the

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universal personal identifier having a patron identification (paragraph 11). More specifically, the universal personal identifier may be a mobile telephone, watch, necklace, key, ring, belt buckle, or any other typical device carried by casino patrons (paragraph 11). Giobbi discloses that the player tracking identifier can be in any design, which may be easily carried by the player. When the player tracking identifier is in the form of a player's typical belonging, the player can easily access the player's information when playing the gaming machine without carrying an extra player tracking card. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedricks' invention and incorporate Giobbi's universal personal identifier, in order to allow players to easily access the players' information without carrying an extra player tracking card.

Hedrick in view of Giobbi further teach the following:

2, 16, 39. The method of claim 1, wherein the UPI device comprises a card reader (Hedrick, col. 2:36).

3, 17, 40. The method of claim 2, wherein the UPI object comprises a credit card (Hedrick, col. 17:26-35).

4, 18, 41. The method of claim 2, wherein the UPI object is selected from the group consisting of a magnetic card, an optical card, a bar coded card, and a memory card (Hedrick, col. 3:9).

5, 19, 42. The method of claim 4, wherein the memory card is selected from the group consisting of a compact flash card, a memory stick, a smart card, a radio frequency card, a combination smart card, and a hybrid card (Hedrick, col. 3:9).

6, 21, 44. The method of claim 1, wherein the UPI device comprises a biometric device, and wherein the universal personal identifier comprises a biometric input by the patron (Hedrick, 10:24).

7, 20, 43. The method of claim 1, wherein the UPI device comprises a touch screen, and wherein the UPI object comprises identifying information entered by the patron, the identifying information being unique to the patron (finger-print reader is a touch screen that identifies the patron, Hedrick, 10:24).

8, 22, 30, 45. Hedrick significantly discloses the claimed invention as discussed above. Hedrick further discloses the a universal person identifier is a portable wireless device with Bluetooth capability such as a personal digital assistant or some other device worn or carried by the player (Hedrick, col. 5:60-6-6), but fails to specifically teach a Bluetooth mobile phone. Giobbi discloses cell phones (paragraph 11). Bluetooth mobile phones are portable devices that have Bluetooth capability. Bluetooth mobile phones are used as a portable communication device to communicate with computers and gaming devices. Having mobile phones to connect to the Hedrick's

gaming device will allow players with mobile phones to connect with player tracking without carrying additional player tracking portable device. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hedrick's gaming device, and incorporate Bluetooth mobile phone in order to allow players with mobile phones to connect with player tracking without carrying additional player tracking portable device.

9, 23, 31, 46. The method of claim 1, wherein the UPI device comprises a Bluetooth.TM. module device, and wherein the UPI object comprises a Bluetooth.TM. handheld device (Hedrick, cols. 5:63-6:6, 6:43-46, 10:46-11:25).

11, 25, 33, 48. The method of claim 1, further comprising: detecting a wager for wagering game play at the gaming machine; and providing the patron accounting data to the patron account (Hedrick, col. 2:48-64).

12, 26, 34, 49. The method of claim 11, further comprising enabling the patron to access the patron account if the patron identification matches the unique patron identification (Hedrick, cols 17:38-44).

13, 27, 35, 50. Hedrick significantly discloses the claimed invention as discussed above. Hedrick further discloses applying a promotional credit to the patron account based on the patron accounting data; enabling the patron to access the patron account

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if the patron identification matches the unique patron identification; and enabling the patron to transfer the promotional credit to the gaming machine (as noted in the claims above). However Hedrick fails to teach permitting the patron to wager the promotional credit for wagering game play on the gaming machine. However, it is well known in the art to provide various promotional credits to a patron. Many promotional awards are provided by the casino, which can be purchased by the promotional credits. One common promotional award is wagering credits used for the casino. Wagering credits encourages the patron to revisit the casino and stay in the casino longer. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick's gaming device and permit the patron to wager the promotional credit for wagering game play on a gaming machine, in order to encourage the patron to revisit the casino and stay in the casino longer.

14, 37. The method of claim 1, wherein the wagering game is selected from the group consisting of mechanical slots, video slots, video poker, video blackjack, video keno and video bingo (Hedrick, col. 2:26-61).

28. The method of claim 15, wherein the spending activity is selected from the group consisting of lodging spending, restaurant spending, entertainment spending, and merchandise spending (spending on entertainment such as a wagering game, meals and rooms, Hedrick, col. 17:52-59).

29. See rejection for claim 1. Furthermore, Hedrick discloses Bluetooth for wireless communication (col. 6:3).

32. The method of claim 29, wherein detecting establishment of a Bluetooth T wireless connection comprises: detecting establishment of a Bluetooth.TM. link between the Bluetooth.TM. module and the Bluetooth.TM. portable device; detecting establishment of a Bluetooth.TM. channel between the Bluetooth.TM. module and the Bluetooth.TM. portable device; and detecting establishment of a Bluetooth.TM. high layer connection between the Bluetooth.TM. module and the Bluetooth.TM. portable device (standard Bluetooth wireless communication protocol, Hedrick, cols. 5:66-6:6, 10:57-25).

36. The method of claim 29, further comprising disabling collection of the patron accounting data resulting from wagering game play when the Bluetooth.TM. wireless connection between the Bluetooth.TM. module and the Bluetooth.TM. portable device is not established (A connection between the portable device and the player tracking unit is required for the patron to access the accounting data from the server. Therefore access to the accounting data from the server is disabled when a connection is not established, Hedrick, cols. 2:48-54, 3:5-47, 10:46-11:25).

Claim 50. The UPI device is capable of reading a plurality of types of the UPI object (i.e. biometric input device and card, Hedrick, col. 10:38-40), including at least

one of a magnetic card, an optical card, a bar coded card, and memory card (Hedrick discloses magnetic card, col. 3:8). Furthermore, the claimed type of UPI objects is considered to be art equivalent. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have the UPI device capable of reading plurality types of UPI objects such as magnetic card, an optical card, a bar coded card, and memory card in order to receive patron gaming identification from various object that store information using different methods.

Claims 10, 24, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick et al (US 6,908,387) in view of Giobbi (US 2003/0045354) as applied to claims 1, 15, 38 above, and further in view of Kermode (GB 2363950)

Hedrick in view of Giobbi discloses the claimed invention as discussed above. However, Hedrick in view of Giobbi fails to teach the universal personal identifier comprises a microchip embedded in the patron. However, in an analogous art to data storage. An embedded microchip in a person allows the person to easily access the information contained in the embedded microchip, without having the person to carry an external storage device. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick in view of Giobbi's gaming system, and incorporate Kermode embedded microchip, in order to allow player access player tracking information without carrying an external tracking device.

Response to Arguments

Applicant's arguments filed 7/27/08 have been fully considered but they are not persuasive.

Regarding the 112 rejection directed to the claim element "a primary purpose is not directed to identifying the patron at a game venue" Applicants argue that the specification provide support for this limitation. During the interview, it was discussed that examples of the UPI object, such as a credit card or a driver's license have primary purpose. However, as noted in the 112 rejection above, the sole purpose of the UPI object in the claimed invention is used to provide a unique patron gaming identification with a patron. See the 112 rejection above. Applicants further argue that the specification describes that "the patron can be readily identified without having previously registered using the more formal registration procedure." However, this description is directed to a patron being identified and registered. The description does not support what the primary purpose is, and how the primary purpose is not directed to identifying the patron at a game venue when the UPI object is used to provide a unique patron gaming identification with a patron.

Regarding claims 1-51, Applicants argue that Hedrick view of Giobbi fails to disclose at least one claim element such as the "universal" concept, or "a UPI object in a form of a tangible object whose primary purpose is not directed to identifying the patron at a particular gaming machine." However these limitations have been addressed above.

After considering Applicants' arguments, it appears that the claimed invention is directed to a player tracking device in which a player tracking unit carried by a player, and the player tracking unit can be used by multiple gaming sites. This will eliminate the need to carry a specific player tracking unit by the player. Prior art discloses these limitations. See cited references below.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jorasch (US 5,967,896) discloses a credit card is used to identify a casino account.

Fertitta (US 6,302,793) discloses a player tracking card that is used to track a player at a plurality of gaming venues.

Rowe (US 2002/0103027) discloses a method of using a credit card as a player tracking unit. The player tracking unit may be used in multiple casinos.

Pease (US 5,766,076) discloses a player tracking card associated a player identification information that is then used to determine the player account held in the central computer system. Other types of player tracker systems can be use used such as systems which accept an ordinary credit card or debit card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASSON H. YOO whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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